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| EXAMINER |
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MOHANDESI, JILA M

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| ART UNIT | PAPER NUMBER |
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3728

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05/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,741

Applicant(s)

KOO, JOHN C. S.

Examiner

Jila M. Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Appeal Brief 01/24/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the appeal brief filed on January 24, 2007, PROSECUTION IS HEREBY REOPENED and the finality of the last action is withdrawn. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Kester et al. 4,356,643. Kester '643 discloses substantially all the limitations of the claims

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including the following: a shoe (see Figure 2) comprising a bottom surface (bottom of 11) that is adjacent to the ground in normal use and that has a plurality of indentations (that located between projections 14), with lower extending portions 14 between the indentations (see Figure 2); a sole 11 that forms at least a portion of the bottom surface; an upper portion 13 extending above the sole; a plurality of small particles 18 bonded (see col. 2, lines 16-19) differentially to different areas of the bottom surface, with each of a plurality of the lower extending portions being coated more than each of the plurality of the indentations (see Figure 2, surface area of the lower extending portions which includes two sidewalls and a horizontal sidewall is much larger than the surface area of the indentations, therefore the lower extending portions are coated more than each of the plurality of the indentations); at least 1,000 small particles are bonded to the at least some lower extending portions (see Figure 3); the small particles are bonded to the at least some of the lower extending portions using adhesive material (see col. 2, lines 16-19); the small particles comprises a fabric material (18 is made of nylon material, a fabric material); the small particles have been bonded directly onto the at least some of the lower extending portions (see Figures 2 and 3); the sole is sufficiently durable for commercially acceptable outdoor use (see col. 2, lines 20-31); the sole includes an outsole that is comprised of at least one of leather, natural rubber and synthetic rubber (see col. 1, lines 43-49); the small particles cover at least 50% of the portion of the bottom surface that normally comes into contact with the ground (see Figures 1-3); the sole is sufficiently strong for commercially acceptable outdoor use (see col. 1, lines 4-47); the bottom surface has at least five indentations (see Figure 2); at

least some of the indentations are very narrow (see portion at front edge of heel); at least one of the indentations is approximately 1-2 millimeters in width (see indentations in forefoot area); at least some of the indentations are closely spaced (see First two indentations at front edge of heel in Figure 2); at least two of the indentations are separated from each other by no more than approximately 2 millimeters (see first two indentations at front edge of heel); a plurality of small particles bonded differentially to different areas of the bottom surface (see Figures 1 and 5, bonded in different directions); the indentations ordinarily do not contact the ground (see Figure 2).

With respect to claims 32 and 35, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-8, 10-20 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin 4,658,514 in view of Root 2,793,136. Shin '514 teaches a shoe comprising a bottom surface that is adjacent to the ground in normal use and that the sole of a shoe has a plurality of protrusions 76 and a plurality of indentations (slots 50, see col. 3, lines 10-23) with only the protrusions having ridges 78 applied thereto to aid in affording traction to the user. Shin '514 further teaches that the indentations (slots 50) are provided to act as hinges and allow bending of the sole. Shin '514 shows these indentations without any traction elements because this section does not touch the ground and the traction elements would prevent complete bending of the sole in these areas. Shin '514 does not appear to disclose having a plurality of small particles bonded to at least the lower portions of the protrusions. Root '136 discloses that it is desirable to bond a plurality of small articles to the bottom of shoe in place of ridges to provide better slip-resistant surface. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to replace the ridges on the lower extending portions of the protrusions of Shin '514 with the adhesively bonding small particles as taught by Root '136 to provide better slip-resistant surface.

Shin '514 as modified by Root '136 will have at least 1,000 small particles bonded to the at least some lower extending portions (see column 5, lines 34-58 of Root '136); the small particles are bonded to the at least some of the lower extending portions using adhesive material; the small particles comprises a fabric material (see column 4, lines 49-51 of Root '136); the small particles have been bonded directly onto the at least some of the lower extending portions; the sole is sufficiently durable for

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commercially acceptable outdoor use (see col. 2, lines 20-31); the sole includes an outsole that is comprised of solid rubber or other wear-resistant material; the small particles cover at least 50% of the portion of the bottom surface that normally comes into contact with the ground (see Figure 3A of Shin '514 where the ridges are replaced with plurality of small particle bonded there on); the sole is sufficiently strong for commercially acceptable outdoor use (see col. 2, lines 59-61 of Shin '514); the bottom surface has at least five indentations (see Figures 1 and 3A of Shin '514); at least some of the indentations are very narrow (see Figure 2 of Shin '514); at least one of the indentations appears to be approximately 1-2 millimeters in width (see indentations in forefoot area); at least some of the indentations are closely spaced (see First two indentations at front part of the toe area in Figure 2 of shin '514); at least two of the indentations appear to be separated from each other by no more than approximately 2 millimeters. Furthermore, it would have been an obvious matter of design choice to modify the size of the indentations, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

With respect to claims 4, Root '136 discloses embedding the small particles directly into said bottom surface using heat (see column 5, lines 50-58).

With respect to claims 4 and 6, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the

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same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

With respect to claims 8 and 10, see column 5, lines 8-10 of Root '136.

The references as applied to claim 1 above disclose all the limitations of the claims except for the for the particle material being made of natural or synthetic leather, natural or synthetic rubber, plastic, Root '156 discloses that a variety of particles can be used for forming the slip resistant surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the particles of the references as applied to claim 1 out of natural or synthetic leather, natural or synthetic rubber, or plastic as these materials are well known and used in the art for aiding in slip prevention.

With respect to claims 13-18, it appears that the ASTM tear resistance and abrasion resistance requirements are standards, therefore, it would be well within the skill of one of ordinary skill in the art to make a sole to meet these requirements. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole of the references as applied to claim 1 above meet the tear and abrasion resistance standards.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above and further in view of Bible 4,779,360. Shin-Root as modified above discloses all the limitations of the claim except for the particles

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comprising metal. Bible '360 teaches that grit material used to gain grip on slippery surfaces can be made of aluminum oxide, silicon carbide or tungsten carbide (i.e. metals) for their durability, less tendency to crumble and their hardness to scratch or furrow up metallic slippery surfaces. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the grit particles of Shin-Root as applied to claim 1 above out of metal, as taught by Bible '360, to aid in gaining grip on metallic or rough surfaces.

8. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 1 and further in view Schaffer et al. 5,276,981. Shin-Root as modified above discloses all the limitations of the claims except for the particle wearing off over certain time frames. Schaffer et al. '981 teaches that the material for particles attached to the bottom of shoe soles to aid in gaining traction can be modified to wear over given time frames, including weeks (see col. 2, lines 3-21). Therefore, it would have been well within the skill of one of ordinary skill in the art, to modify the material of the particles attached to the sole of Shin-Root as applied to claim 1 above to last over any time period desired, as taught by Schaffer et al. '981, to determine the wear life of the sole of the shoe.

Response to Arguments


9. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
May 10, 2007


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